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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/444,507	11/22/1999	ANDREW L. DIRIENZO	VPR-001US	8746

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WESTERLUND & POWELL PC
122 N ALFRED STREET
ALEXANDRIA, VA 223143011

EXAMINER

BLECK, CAROLYN M

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/444,507	DIRIENZO, ANDREW L.
	Examiner	Art Unit
	Carolyn M Bleck	3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 October 2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on 02 October 2002 is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. . | 6) <input type="checkbox"/> Other: _____ . |

Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 2 October 2002.

Claims 1-18 remain pending.

Priority

2. The objection to the specification because a specific reference to the prior application in the first sentence of the specification or in an application data sheet for priority was missing, is hereby withdrawn due to the amendment filed 2 October 2002.

Drawings

3. The objections to the drawings are hereby withdrawn due to the amendment filed 2 October 2002.

4. Formal correction of the noted defect(s) can be deferred until the application is allowed by the examiner.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 7, 9-12, 14-16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eberhardt (5,832,488) in view of Garcia (5, 065, 315) as cited in the previous Office Action (paper number 2), for substantially the same reasons given in the prior Office Action (paper number 2). Further reasons appear hereinbelow.

(A) Claims 1-5, 7, 9-12, 14-16, and 18 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 2, section 7, pages 3-9), and incorporated herein. Further reasons appear hereinbelow.

7. Claims 6, 8, 13, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eberhardt and Garcia as applied to claims 4-5, 7, 11-12, and 15-16 above, and further in view of Sujansky ("The Benefits and Challenges of an Electronic Medical Record: Much More than a "Word-Processed" Patient Chart", *Western Journal of Medicine*, San Francisco, vol. 169, September 1998, pages 176-183) as cited in the previous Office Action (paper number 2), for substantially the same reasons given in the prior Office Action (paper number 2). Further reasons appear hereinbelow.

(A) Claims 6, 8, 13, and 17 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 2, section 7, pages 9-10), and incorporated herein. Further reasons appear hereinbelow.

Response to Arguments

8. Applicant's arguments filed 2 October 2002 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 2 October 2002.

(A) At pages 3-4 of the 2 October 2002 response, Applicant argues that the reliance on the claims in a patent reference as teaching a specific element of a pending claim is improper.

In response to Applicant's concern that the Examiner relied on selected portions of the Eberhardt reference, for example column 18, it is respectfully submitted that the reliance on Eberhardt in the rejection of claim 4 included citations to both the claims and descriptive part of the specification of Eberhardt as shown here: "creating a critical information file for each patient" (descriptive part of the specification: col. 7 line 54 to col. 8 line 10, col. 10 lines 38-45 and claims: col. 18 lines 15-18).

In response to Applicant's concern that the Examiner rejected claim 1 of the instant application on the basis of claim 15 of the Garcia patent resulting in a case of *prima facie* error, the Examiner respectfully submits that the reliance on Garcia in the rejection of claim 1 included citations to both the claims and descriptive part of the specification of Garcia as shown here: "a computer system for hospital records management, wherein a paper patient chart is used to store and report patient information such as medical data, test results, scheduling information, and important documents (descriptive part of the specification: col. 1 lines 13-55, col. 3 line 58 to col.

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4 line 4, col. 10 lines 1-5, and claims: col. 31 lines 50-52), and wherein information in the electronic patient record is first entered through a computer and then printed for inclusion in the patient record (descriptive part of the specification: col. 6 line 1 –18 and claims: col. 32 line 10-13 and 33-38)."

Therefore, Applicant's reliance on *in re Benno* is inapposite, since the Examiner has clearly shown that both the descriptive part of the specification and the claims were relied upon in the rejection of the claimed invention as addressed in the previous Office (see paper number 2) and above in the present Office Action.

(B) At pages 4-6 of the 2 October 2002 response, Applicant cites several court cases to argue that a *prima facie* case of obviousness has not been clearly established, that there is no motivation to combine the references, and that certain features of the claimed invention are not taught by the applied references.

In response, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that she has at least satisfied the burden of presenting a *prima facie* case of obviousness, since she has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the

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motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 2). Note, for example, the motivations explicitly stated at the first full paragraph of page 4 of the previous Office Action (i.e., "allowing a health care specialist to quickly ascertain important facts about a patient using the critical information file, such as in an emergency (Eberhardt, col. 7 lines 56-60), and increasing the efficiency and reducing the paperwork required to update a paper patient chart (Garcia, col. 2 lines 23-28) ...").

Moreover, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specifically support that particular motivation and/or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

In response to Applicant's concern that the Examiner has ignored the mandate of the modern case law which clearly and explicitly hold that in order for the references to be combined in that the references must explicitly teach or suggest every element of the combination as well as how to use such a combination, the Examiner respectfully submits that Applicant misinterprets some of the case law cited. For example, the Court

in *In re Fritch* stated "[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. [emphasis added]" *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Each applied reference does not expressly suggest combination with the other respective references; however, the Examiner has shown that motivation for combining the references existed in the prior art. The "modification" referred to in *In re Fritch* involves extensive changes to the primary references. Such is not the case in the present combinations, where all modifications proposed by the Examiner are specifically taught by the references and that knowledge generally available to one of ordinary skill in the art. Therefore, the combination of references is proper and the rejection maintained.

Furthermore, in response to the Applicant's concern that Eberhardt teaches away from the concept of working with paper files, Eberhardt discloses "printing the contents of a window that is currently key" (col. 15 lines 5-15) or "printing a record" as shown in Figure 2. It appears the Applicant fails to consider other non-preferred embodiments of Eberhardt. In particular, Eberhardt's preferred embodiment appears to be a computer system and method for storing individual medical histories on a storage device (Eberhardt; Abstract and col. 1 lines 10-16). However, Eberhardt includes a printing function as discussed above (see Fig. 2 and col. 15 lines 5-15). It is respectfully

submitted that "printing a record" as shown in Figure 2 is considered to be a form of a "... concept of working with paper files..."

Therefore, in response to the Applicant's assertion that the Examiner has not set forth cogent reasoning for the combination given the actual teachings of the applied references, the Examiner respectfully disagrees as clear motivations were explicitly stated in the present Office Action and previous Office action (see paper number 2) and an example is further reiterated here: "...allowing a health care specialist to quickly ascertain important facts about a patient using the critical information file, such as in an emergency (Eberhardt, col. 7 lines 56-60), and increasing the efficiency and reducing the paperwork required to update a paper patient chart (Garcia, col. 2 lines 23-28)." In addition, Applicant's remarks with regard to the motivation to incorporate this feature into the method taught collectively by the applied references apparently ignores the Examiner's statement in its entirety. In particular, the Examiner had specifically stated in paper number 2, section 7(A), pg. 4 first full paragraph, "At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of Garcia within Eberhardt's patient record with the motivation of allowing a health care specialist to quickly ascertain important facts about a patient using the critical information file, such as in an emergency (Eberhardt, col. 7 lines 56-60), and increasing the efficiency and reducing the paperwork required to update a paper patient chart (Garcia, col. 2 lines 23-28)." The Examiner respectfully submits that the courts have broadly held that it is sufficient if the prior art clearly suggests doing what Applicants have done, although an underlying explanation of exactly why this

should be done is not taught as suggested by the cited references (i.e. the concept of using paper patient files). *In re Gershon*, 152 USPQ 602 (CCPA 1967). Moreover, the fact that Appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Further, according to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner both in the present Office Action as well as the prior Office Action, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references, separately and in a vacuum, without considering the knowledge of average

skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

In reference to the Applicant's specific arguments with respect to the limitation found in claim 1 regarding "wherein the information in the VPR [vital patient record] takes precedence over corresponding information in the HCPR [hard copy patient record]," the Examiner respectfully submits that Applicant's statements appear to be misdescriptive of the full teachings of Eberhardt in combination with Garcia. In particular, Applicant asserts that this recitation is not found within the four corners of the Garcia reference and that the applied references do not teach or suggest such a feature. However, this is not the case, especially when considering that Garcia includes entering information such as nurse's initial assessments, patient readings, such as blood pressure, temperature, fluid intake and output, and other similar information into a station terminal, wherein the information is stored in a central computer, and wherein the information is able to be printed (col. 6 lines 1-18 and col. 32 lines 10-13 and 33-38). It is noted that Garcia discloses entering the information first in a computer where the information can then be printed when needed (col. 6 lines 1-18). Therefore this method of maintaining patient records is considered to be a form of the electronic record taking precedence over the paper record.

In light of the above, the Examiner respectfully submits that it is sufficient to demonstrate that the prior art meets the limitations as claims, whether by a single instance or scenario, or in every possibly preferred embodiment. Thus, the fact situations provided by the Examiner, no matter how infrequent or occasional they may

be, are indeed embodiments that Applicant is expected to have considered. As such, since Applicant fails to expressly recite limitations that provide a patentable distinction over such fact situations, it is respectfully submitted that prior art either reads on or makes obvious Applicant's claimed limitations.

(C) At pages 6-8 of the 2 October response, Applicant argues that certain features of the claimed invention are not disclosed by the applied reference.

In response, the Examiner respectfully notes that the cited reference was never applied as a reference under 35 U.S.C. 102 against the pending claims. As such, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teaches the claimed features, *per se*, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of these features. Regarding this issue, it is well established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;

- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

As such, it is respectfully submitted that Applicant appears to view the applied references in a vacuum without considering the knowledge of average skill in the art. In reference to Applicant's specific arguments regarding the assertion that Eberhardt and Garcia either alone or in combination, teach nothing with respect to "inserting a printed copy of the VPR whenever the HCPR is accessed in the healthcare provider's office," the Examiner respectfully submits that Applicant's statements appear to be misdescriptive of the full teachings of Eberhardt. In particular, Eberhardt teaches creating a critical information file for each patient (col. 7 line 54 to col. 8 line 10, col. 10

lines 38-45, and col. 18 lines 15-18), "printing the contents of a window that is currently key" (col. 15 lines 5-15), or "printing a record" as shown in Figure 2. Furthermore, Eberhardt teaches opening a medical history, and then using the main menu to print a record (see col. 9 lines 18-33). As such, it is apparent that Eberhardt teaches printing a copy of the critical information file. Further, Garcia teaches cataloguing a patient entry by name and/or social security number in a master database, sortable by name and/or SSN so that next time the patient enters the hospital, the pertinent information may be retrieved, reprinted, and placed in a patient's chart (col. 6 lines 10-12, col. 9 lines 4-20, col. 10 lines 1-5, and col. 32 lines 33-38). Thus the artisan viewing Eberhardt and Garcia collectively as a system, would have understood that the features of Garcia, namely retrieving, reprinting, and placing a copy of the record in a patient chart, combined with the method of Eberhardt would have been obvious with the motivation as stated in the previous Office Action (see paper number 2 page 6 last paragraph) allowing a health care specialist to quickly ascertain important facts about a patient, such as in an emergency (Eberhardt, col. 7 lines 56-60), providing accurate, up to date, medical information (Eberhardt, col. 3 lines 26-30), and more efficiently and easily displaying patient information (Garcia, col. 2 lines 23-47).

It is noted that with regard to "maintaining vital patient information complementing a hardcopy patient record (HCPR) maintained at a healthcare provider's office," the step of "inserting a printed copy of the VPR whenever the HCPR is accessed in the healthcare provider's office" is considered to be a form of maintaining records.

In light of the above, the Examiner respectfully submits that it is sufficient to demonstrate that the prior art meets the limitations as claimed, whether by a single instance or scenario, or in every possibly preferred embodiment. Thus, the fact situations provided by the Examiner, no matter how infrequent or occasional they may be, are indeed embodiments that Applicant is expected to have considered. As such, since Applicant fails to expressly recite limitations that provide a patentable distinction over such fact situations, it is respectfully submitted that prior art either reads on or makes obvious Applicant's claimed limitations.

In response to applicant's arguments against combining the references, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition the test for obviousness is not whether the features of a secondary reference may be bodily incorporated in the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

(E) Applicant's remaining arguments at pages 7-8 rely upon those arguments addressed above, and are likewise moot for the reasons set forth in the preceding responses.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-8374 [Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).

AB
CB
December 2, 2002

Dinh X. Nguyen
DINH X. NGUYEN
PRIMARY EXAMINER